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09/917,956	07/31/2001	Toshiki Kindo	041-1894D	3203

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EXAMINER

BELL, MELTIN

ART UNIT	PAPER NUMBER
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2121

DATE MAILED: 12/31/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/917,956

Applicant(s)

KINDO, TOSHIKI

Examiner

Meltin Bell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2001 and 18 October 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33-38 is/are pending in the application.
- 4a) Of the above claim(s) 1-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 33-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 July 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4 . 6) ☐ Other: _____

DETAILED ACTION

This action is responsive to application **09/917,956** filed 07/31/01 and its preliminary amendment 10/18/01.

Claims 1-32 have been cancelled by the applicant and are therefore withdrawn from consideration. Claims 33 (New) through 38 (New) have been examined.

Priority

Applicant is advised of possible benefits under 35 U.S.C. 119(a)-(d), wherein an application for patent filed in the United States may be entitled to the benefit of the filing date of a prior application filed in a foreign country.

Acknowledgment is made of applicant's claim for foreign priority based on applications filed in Japan #s 7-226172 on 09/04/95 and 8-031547 on 02/20/96. It is noted, however, that applicant has not filed a certified copy of either Japanese application as required by 35 U.S.C. 119(b).

Information Disclosure Statement

Applicant is respectfully reminded of the ongoing Duty to disclose 37 C.F.R. 1.56 all pertinent information and material pertaining to the patentability of applicant's claimed invention, by submitting in a timely manner PTO-1449, Information Disclosure Statement (IDS) with the filing of applicant's application or thereafter.

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The information disclosure statement filed 10/18/01 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because of missing or inaccurate information in the listing:

- All U.S. Patents are missing the day of publication
- U.S. Patent Number 5,802,504 was published in September of 1998
- References (Ojala, Chen, Kawai and Nomura) are missing their dates of publication

It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

Drawings

The United States Patent and Trademark Office of Draftperson's Patent Drawings Review have reviewed the formal drawings. They are objected to by the Draftsperson under 37 CFR 1.84 or 1.152 for the reasons indicated on the Form PTO-948, Notice of Draftsperson's Patent Drawing Review.

The drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is required in correcting any errors of which applicant may become aware in the drawings.

The drawings are objected to because:

- Fig. 2 doesn't show the information recording medium 53 of page 9, lines 3-4.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is required in correcting any errors of which applicant may become aware in the specification.

The disclosure is objected to because of the following informalities:

- 2 should be 1 on page 6, line 15
- Learning unit 51 on page 9, line 16 should be learning unit 52 or interface unit 51.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The invention as disclosed in claim 33 is directed to non-statutory subject matter.

Claims 33 is rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a credible asserted utility or a well established utility.

As a method, claim 33 offers abstract ideas (e.g. "information data", "keywords") that are also not applied in the technological arts. Abstract ideas and their manipulation constitute "descriptive material" that is not patentable, *Warmerdam*, 33 F.3d at 1360, 31 USPQ2d at 1759 and *Schrader*, 22 F.3d at 292-93, 30 USPQ2d at 1457-58, respectively. If the abstract ideas of claim 33 represented functional descriptive material consisting of data structures and computer programs which impart functionality when employed as a computer component (recorded on some computer readable medium), they become structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. For examples,

- *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) offers claim to data structure stored on a computer readable medium that increases computer efficiency held statutory and
- *Warmerdam*, 33 F.3d at 1360-61, 31 USPQ2d at 1759 offers product-by-process claim to computer having a specific data structure stored in memory also held statutory while
- *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 offers claim to a data structure *per se* held nonstatutory.

Because claim 33 does not claim to be practiced on a computer and/or stored on a computer readable medium, it is not limited to practical applications in the technological arts. Specifically, the claim is a method without any particular practical application, such as a program running on a computer and stored in a computer readable medium or memory. On that basis alone, claim 33 is clearly nonstatutory.

Claim 33 is rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a credible asserted utility or a well established utility. Claim 33 is also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a credible asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

Double Patenting

To expedite a complete examination of the instant application, the claims rejected under 35 U.S.C. 101 (nonstatutory) above are further rejected as set forth below in anticipation of applicant amending these claims to place them within the four statutory categories of invention.

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in

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scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101. Claim 33 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1 and 7, respectively, of prior U.S. Patent No. 6,647,378. This is a double patenting rejection.

If claim 33 of this application and claims 1 and 7 of U.S. Patent No. 6,647,378 cover different inventions, the following obviousness type rejection applies: The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 7, respectively, of U.S. Patent No. 6,647,378. Although the conflicting claims are not identical, they will not be patentably distinct from each other when claim 33 of this application is rewritten to use a computer readable or information recording medium.

Claim Rejections - 35 USC § 112

To expedite a complete examination of the instant application, the claims rejected under 35 U.S.C. 101 (nonstatutory) above are further rejected as set forth below in anticipation of applicant amending these claims to place them within the four statutory categories of invention.

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The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 33 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Support for this 35 U.S.C. 112, first paragraph rejections comes from MPEP 2164.07(I)(A):

"As noted in *In re Fouche*, 439 F.2d 1237, 169 USPQ 429 (CCPA 1971), if "compositions are in fact useless, appellant's specification cannot have taught how to use them." 439 F.2d at 1243, 169 USPQ at 434. The examiner should make both rejections (i.e., a rejection under 35 U.S.C. 112, first paragraph and a rejection under 35 U.S.C. 101) where the subject matter of a claim has been shown to be nonuseful or inoperative. The 35 U.S.C. 112, first paragraph, rejection should indicate that because the invention as claimed does not have utility, a person skilled in the art would not be able to use the invention as claimed, and as such, the claim is defective under 35 U.S.C. 112, first paragraph."

Claim Rejections - 35 USC § 102

To expedite a complete examination of the instant application, the claims rejected under 35 U.S.C. 101 (nonstatutory) above are further rejected as set forth below in anticipation of applicant amending these claims to place them within the four statutory categories of invention.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 33 (New) through 38 (New) are rejected under 35 U.S.C. 102(b) as being anticipated by *Morita* U.S. Patent Number 5,297,042 (March 22, 1994).

Regarding claim 33:

Morita teaches,

- calculating a prediction value predicting a user's necessity degree for the provided information data on the basis of a user's input showing that the provided information data are necessary or unnecessary for the user (column 2, lines 58-60, "The associative retrieval...the importance values")
- assigning the prediction value to each of the keywords (column 5, lines 21-31, "it is possible...the expected values");

Regarding claim 34:

Rejection of claim 33 is incorporated. Therefore, claim 34 is rejected under the same rationale as claim 33.

Regarding claim 35:

Rejection of claim 33 is incorporated and claim 35's further limitations are taught in *Morita*,

- a first frequency, at which the user shows that the information data included in the information to which each keyword is attached are necessary (column 1, lines 56-57, "a weight value for each keyword")

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- a second frequency, at which the user shows that the information data included in the information to which each keyword is attached are unnecessary (column 1, lines 61-64, "second factors corresponding... of a keyword")

Regarding claim 36:

Rejection of claim 35 is incorporated. Therefore, claim 36 is rejected under the same rationale as claim 35.

Regarding claim 37:

Rejection of claim 33 is incorporated and claim 37's further limitations are taught in *Morita*,

- a first frequency, at which the user provides an input showing that the provided information data are necessary (column 1, lines 54-55, "a document retrieval... a retrieval condition")

- a second frequency, at which the user provides an input showing that the provided information data are unnecessary (column 5, lines 20-23, "When there is... to the document")

- a third frequency, at which the user shows that the information data included in the information to which each keyword is attached are necessary (column 2, lines 49-51, "Each of the... between the keywords")

- a fourth frequency, at which the user shows that the information data included in the information to which each keyword is attached are unnecessary (column 2, lines 51-53, "each of the... in each document")

Regarding claim 38:

Rejection of claim 37 is incorporated. Therefore, claim 38 is rejected under the same rationale as claim 37.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- *Morita*; U.S. Patent Number 5,297,042
- *Wang et al*; U.S. Patent Number 5,276,772
- *Kuga et al*; U.S. Patent Number 5,280,573
- *Huang et al*; "A Fast Algorithm for Large Vocabulary Keyword Spotting Application"; IEEE Transactions on Speech and Audio Processing; Vol. 2, Iss. 3; July 1994; pp 449-452
- Applying prediction value of information data (e.g. document) to each keyword:
 - *In re Dulberg*, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961) Making separable
 - *In re Harza*, 274 F.2d 669, 671, 124 USPQ 378, 380 (CCPA 1960) Duplicating part for a multiple effect


Any inquiry concerning this communication or earlier communications from the Office should be directed to Melvin Bell whose telephone number is 703-305-0362.

This Examiner can normally be reached on Mon - Fri 7:30 am - 4:30 pm.

If attempts to reach this Examiner by telephone are unsuccessful, his supervisor, Anil Khatri, can be reached on 703-305-0282. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

MB /M.B.,


ANIL KHATRI
SUPERVISORY PATENT EXAMINER